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Dominique Briere

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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/902,475
Filing Date: July 09, 2001
Appellant(s): BRIERE ET AL.

Jeffrey A. Cooper of Alston & Bird LLP
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/4/08 appealing from the Office action mailed 6/1/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Ex parte Dominique Briere, Leon Coisy, Paul La Barre and Pascal Santais, Appeal No. 2006-0123, Application No. 09/553,413, Board of Patent Appeals and Interferences, decision dated May 11, 2006.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 22-31 and 45-47 are allowed due to the new declaration filed 11/29/07.

This appeal involves claims 48-51 rejected under 35 U.S.C. § 251 as being improper recapture of subject matter surrendered during prosecution of U.S. Patent No. 5,968,560. The omission of claim 51 from the rejection statement of June 1, 2007 was a typographical error.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claims 22-31 and 45-51 rejected under 37 C.F.R. § 1.175(b)(1). A supplemental declaration filed 11/29/07 has been approved by the examiner.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 48-51 stand rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which

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was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claims 22-31 and 45-47 contain the phrase "said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures movable one with respect to the other" and contain the shell holder as a positive structural limitation in the claim; therefore, claims 22-31 and 45-47 contain the implicit limitation of the shape of the shell holders as set out in the "decision by the Board of Patent Appeals and Interferences in parent application 09/553,413 and do not involve recapture.

Claims 48-51 recite the mold shell assembly without positively claiming the shell holders or the mold carriers in the form of enveloping structures. Applicant attempts to overcome a recapture rejection by using the following phrase "said mold shells being configured to be supported by mold carriers made in the form of enveloping structures via interposed mold shell holders, said mold shell holders being shaped to be supported by said mold carriers in the form of enveloping structures". The original patent claim contained the element "a shell which is provided with a half-impression of the container to be obtained and which can be removably fastened to its shell holder by quick-fixing means, the shell and shell holder being in complementary shapes in order to be in at

least partial mutual thermal-conduction". The explicit amendment to the mold carriers and the implicit amendment to the shell holders of claim 1 of Patent 5,968,560 did not extend to the shape of the shell. It appears unlikely that applicant intended to further define the shape of the shell in the amendment of the Patent -560 by amending the mold carriers which are made in the form of enveloping structures. The language in the claim regarding the complimentary shape of the shell and shell holders was merely for the purpose of being in at least partial mutual thermal-conduction. The Board must make such a determination as to the implicit modification of the shape of the shell via the implicit modification an interposing shell holder, as the previous decision did not specifically reference shape of the shells being modified during prosecution of the Patent-560.

(10) Response to Argument

Appellant asserts that the Board's reasoning for reversing the recapture rejection in the parent reissue application is applicable to the recapture rejection of the present claims. The present claims 48-51 are directed to a subcombination of the mold shells and a mold bottom. Hence, the mold shell holders and mold carriers are not positive elements of the claims. Does the fact that the present claims 48-51 relate to a subcombination render the recapture rejection moot? Appellant has chosen the language "said mold shells being configured to be supported by mold carriers made in the form of enveloping structures via interposed mold shell holders, said mold shell holder being shaped to be supported by said mold carriers made in the form of enveloping structures". If the subcombination does not make the recapture rejection

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moot, does the mold shells being configured to be supported by mold carriers overcome recapture because the implicit amendment to the mold shell holders apply to the mold shells, as well. The previous Board decision paragraph 1 of page 5 of the Appeal No. 2006-0123 includes that the amendment added to the '560 patent issued expressly limits the two mold carriers such that they are in the form of enveloping structures, but also expressly limits the shape of the shell holders to shapes that can be supported by such enveloping mold carriers. The examiner does not believe that this implicit limitation of the two mold carriers extends to the two mold shells.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein. The previous Board decision is contained in Appendix C of the appeal brief.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Robert B. Davis/

Primary Examiner, Art Unit 1791

April 7, 2008

Conferees:

/Christine Tierney/

Quality Assurance Specialist, TC 1700

/William Krynski/

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